

REMARKS/ARGUMENTS

Claims 1-10 are active in this application. Claims 9 and 10 find support in Claim 8 and the specification as originally filed. Claim 1 is amended to remove the option of carbonitride as a inner layer material.

The objections noted for Claims 4-8 is no longer applicable. As to the rejection to Claim 3, that the layer is applied by physical vapor deposition limits how the product in claim 3 is made. As this limitation as to making the product of claim 1 is absent, it does, indeed, further limit the claim.

No new matter is added.

The alternative rejections under 35 USC 102(b) or 35 USC 103(a) citing the disclosure of D'Evelyn ('259) is inapplicable to the claims as D'Evelyn does not describe an inner layer of a metal carbide, nitride, or boride and an outer layer of a metal carbonitride deposited on the inner layer.

D'Evelyn describes a single coating layer of the formula  $MC_xNy$  (see [0012] for example). While this formula could be considered to include, amongst others, carbonitride--no examples of carbonitrides are presented. However, as apparent from the claims, the inner layer of material on the core of super hard material is metal carbide, nitride, or boride--which is not described by D'Evelyn. So at least on this basis the rejection under 102 is no longer applicable. Further, as D'Evelyn provides no suggestion (A) to use metal carbide, nitride, or boride as the layer described and (B) to use two layers, inner and outer, as is claimed, the claims cannot be obvious in view of what D'Evelyn describes.

By providing the inner layer chemically bonded to the abrasive and the outer layer compatible with the inner layer, the abrasive is well-protected from attack by matrix components--for which the outer layer is also compatible. As a result, there is improved

Application No. 20/586,393  
Reply to Office Action of November 1, 2007

performance, longer tool life and higher productivity (see pp. 4, line 9 to pp. 5, line 5 of the specification).

Withdrawal of the rejection is requested.

Regarding the provisional rejection based on claims 1-6 of co-pending application 10/585,936 as this rejection is provisional, it is requested that it be held aside. MPEP sec. 804 is noted: *"If 'provisional' ODP rejections in two applications are the only rejections remaining in those applications, the examiner should withdraw the ODP rejection in the earlier filed application thereby permitting that application to issue without need of a terminal disclaimer."*

A Notice of Allowance is requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



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Daniel J. Pereira  
Registration No. 45,518

Customer Number  
**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 08/07)